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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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08/935,377 09/22/97 ZAUDERER

M PENY4-628885

HM12/0330
STERNE, KESSLER, GOLDSTEIN & FOX P. LLC
SUITE 600
1100 NEW YORK AVENUE N.W.
WASHINGTON DC 20005-3934

EXAMINER

EWOLDT, G

ART UNIT

PAPER NUMBER

1644

16

DATE MAILED:

03/30/00

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.

08/935,377

Applicant(s)

Zauderer, M.

Examiner

Gerald Ewoldt

Group Art Unit

1644



☒ Responsive to communication(s) filed on Jan 21, 2000

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 1 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

☒ Claim(s) 7-16 and 43-67 is/are pending in the application.

Of the above, claim(s) _____ is/are withdrawn from consideration.

☐ Claim(s) _____ is/are allowed.

☐ Claim(s) _____ is/are rejected.

☐ Claim(s) _____ is/are objected to.

☒ Claims 7-16 and 43-67 are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been
☐ received.

☐ received in Application No. (Series Code/Serial Number) _____.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☐ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

☒ Fax Transmitted Form

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

DETAILED ACTION

1. The location of your application in the PTO has changed. To aid in correlating any papers for this application, all further correspondence regarding this application should be directed to Dr. Gerald Ewoldt, Art Unit 1644, Group 1640, Technology Center 1600.
2. **Please Note:** In an effort to enhance communication with our customers and reduce processing time, Group 1640 is running a Fax Response Pilot for Written Restriction Requirements. A dedicated Fax machine is in place to receive your responses. The Fax number is 703-305-3704. A Fax cover sheet is attached to this Office Action for your convenience. We encourage your participation in this Pilot program. If you have any questions or suggestions please contact Paula Hutzell, Ph.D., Supervisory Patent Examiner at Paula.Hutzell@uspto.gov or 703-308-4310. Thank you in advance for allowing us to enhance our customer service. Please limit the use of this dedicated Fax number to responses to Written Restrictions.
3. Restriction to one of the following inventions is required under 35 U.S.C. § 121:
 - I. Claims 7-16, drawn to a method for identifying a tumor specific target epitope, classified in Class 435, subclass 7.23
 - II. Claims 43-45 and 59-63, drawn to a method for selecting recombinants encoding a viral target epitope, classified in Class 435, subclass 5.
 - III. Claims 43-62 and 64, drawn to a method for selecting recombinants encoding a fungal target epitope, classified in Class 435, subclass 7.31.
 - IV. Claims 43-62 and 65, drawn to a method for selecting recombinants encoding a mycobacterial target epitope, classified in Class 435, subclass 7.32.
 - V. Claims 43-61 and 66, drawn to a method for selecting recombinants encoding an autoimmune target epitope, classified in Class 435, subclass 7.21.
 - VI. Claims 43-61 and 67, drawn to a method for selecting recombinants encoding a tumor target epitope, classified in Class 435, subclass 7.23.

The inventions are distinct, each from the other because:

4. Groups I-VI are different methods. These inventions require different reagents to identify different types of epitopes and have different endpoints. Therefore they are patentably distinct.

5. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter, restriction for examination purposes as indicated is proper.

6. Irrespective of whichever Group Applicant should elect (Group I, II, III, IV, V, or VI), Applicant is further required under 35 U.S.C. § 121 to:

1) Elect:

A) A **specific** method for identifying a tumor specific target epitope comprising a **specific** tumor cell, a **specific** non-tumorigenic cell line, a specific panel of tumor cell lines, and a **specific** viral vector such as one of those listed in claims 53, 55, or 58 (if Group I is elected).

B) A **specific** method for selecting recombinants encoding a viral target epitope comprising a **specific** method by which test recombinants are constructed (if Group II is elected).

C) A **specific** method for selecting recombinants encoding a fungal, mycobacterial, autoimmune, or tumor target epitope, comprising a **specific** viral vector (such as one of those listed in claims 53, 55, or 58) and a **specific** method by which test recombinants are constructed (if Group III, IV, V, or VI is elected).

2) List all Claims readable thereon including those subsequently added. Currently claim 7 and 43 are generic.

7. Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

The different tumor cells or non-tumorigenic cell lines express different epitopes and will react with different T cells. The different methods of constructing test recombinants employ different reagents and process steps. The different viral vectors, such as herpes or vaccinia, have different properties, infectivities, and growth characteristics. Therefore, the species of Groups I-VI are independent and patentable over one another.

8. Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

9. A telephone call was made to Eric Steffe on 3/13/00 to request an oral election to the above restriction requirement, but did not result in an election being made.


Serial No. 08/935,377
Art Unit 1644

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10. Any inquiry concerning this communication or earlier communications should be directed to the examiner, whose telephone number is (703) 308-9805 and who can normally be reached Monday through Friday from 8:30 am to 5:00 pm. A message may be left on the examiner's voice mail service. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Christina Chan can be reached on (703) 308-3973. Any inquiry of a general nature or relating to the status of this application should be directed to the Technology Center 1600 receptionist whose telephone number is (703) 308-0196.

Papers related to this application may be submitted to Technology Center 1600 by facsimile transmission. Papers should be faxed to Technology Center 1600 via the PTO Fax Center located in Crystal Mall 1. The faxing of such papers must conform with the notice published in the Official Gazette, 1096 OG 30 (November 15, 1989). The CM1 Fax Center telephone number is (703) 305-3014.

G.R. Ewoldt, Ph.D.
Patent Examiner
Group 1640
Technology Center 1600
March 16, 2000


CHRISTINA Y. CHAN
SUPERVISORY PATENT EXAMINER
GROUP 1800/1640



RESTRICTION ELECTION FACSIMILE TRANSMISSION

DATE:

FROM/ATTORNEY:

FIRM:

PAGES, INCLUDING COVERSHEET:

PHONE NUMBER:

TO EXAMINER: Gerald R. Ewoldt, Ph.D.

ART UNIT: 1644

SERIAL NUMBER:

FAX/TELECOPIER NUMBER: (703) 305-3704

**PLEASE NOTE: THIS FACSIMILE NUMBER IS TO BE USED ONLY
FOR RESPONSES TO RESTRICTIONS.**

COMMENTS: _____

IF YOU HAVE NOT RECEIVED ALL THE PAGES OF THIS TRANSMISSION, PLEASE CONTACT THE ATTORNEY AT THE
TELEPHONE NUMBER LISTED ABOVE.

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